



Doc Code: AP.PRE.REQ

PTO/SB/33 (07-05)

Approved for use through xx/xx/200x. OMB 0651-00xx
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

50269-0558

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

on April 28, 2006

Signature

Typed or printed name Angelica Maloney

Application Number

10/648,599

Filed

August 25, 2003

First Named Inventor

Bhavesh Mehta

Art Unit

3622

Examiner

Jeffrey D. Carlson

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

applicant/inventor.

assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

attorney or agent of record.

Registration number _____

Signature

Christopher J. Brokaw

Typed or printed name

(408) 414-1225

Telephone number

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____

April 28, 2006

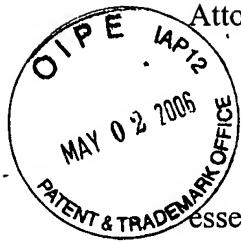
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.

*Total of 5 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.



REMARKS

As will be seen from the discussion below, there are (a) omissions of elements essential for a *prima facie* case in the Examiner's rejections of Claims 3 and 5, and (b) *clear error of fact* in the rejection of the pending claims under 35 U.S.C. § 101.

Issue 1 – Claims 3 and 5 rejected without explanation

The Office Action of December 2, 2005 rejected Claims 3 and 5 under 35 U.S.C. § 103(a) without providing any reason as to why the cited art allegedly discloses, teaches, or suggests Claims 3 and 5. Thus, in response to the Applicants' Amendment and Response received September 19, 2005, no arguments have been presented on the record to justify or explain why Claims 3 and 5 have been rejected under 35 U.S.C. § 103(a). Consequently, a *prima facie* rejection of Claims 3 and 5 under 35 U.S.C. § 103(a) has not been made.

Issue 2 – Claim format previously acknowledged to be useful has been rejected for not being useful under 35 U.S.C. § 101

Claims 1 and 3-10 were rejected under 35 U.S.C. § 101 because allegedly they do not set forth a useful result. The Office Action states:

because claim 1 does not necessarily require the instructions to be executed, the claim is not taken to positively set forth a useful result. Mere sending, receiving and/or storing of these instructions does not accomplish a useful result. In this case, execution of the claimed instructions would however set forth a useful, concrete and tangible result.

The statement that "mere sending, receiving, and/or storing of these instructions does not accomplish a useful result" is a clear error of fact.

It is a fact that obtaining the claimed instructions is a prerequisite of executing the claimed instructions, which is acknowledged to be useful. A computing device cannot execute instructions that it does not possess. Thus, in order to execute instructions, an entity must first obtain the instructions. Logic dictates that it must be useful to perform an operation that is a prerequisite to achieving a useful result.

An entity may obtain instructions by receiving the instructions from another entity that is sending the instructions. By a first entity sending the claimed instructions to a second entity, the first entity is enabling the second entity to subsequently execute the

claimed instructions. In this way, sending and receiving the claimed instructions are useful because these acts enable an entity to execute the claimed instructions, which is acknowledged to be useful.

Moreover, the claim format currently recited in Claims 1 and 3-10 has already been acknowledged to be useful by the Patent Office. For example, U.S. Patent No. 7,024,656 recites the same claim format as used by Claims 1 and 3-10 in the pending application. Further, numerous patent applications have been allowed that also recite the same claim format as used by Claims 1 and 3-10, such as U.S. Patent Application Nos.: 09/872,986, 10/124,908, and 10/724,834.

For at least the above reasons, Applicants respectfully request that (a) Claims 3 and 5 either be allowed or a *prima facie* rejection explaining why Claims 3 and 5 are not allowable be provided, and (b) Claims 1 and 3-10 be acknowledged to be useful in accordance with 35 U.S.C. § 101.